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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,946	10/04/2000	Deborah L. Caswell	10005371-1	2912

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EXAMINER	
LANIER, BENJAMIN E	
ART UNIT	**PAPER NUMBER**
2132	

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/684,946	CASWELL ET AL.	
	Examiner	Art Unit	
	Benjamin E Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-9 and 11-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-9 and 11-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 December 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 20 December 2004 amends claims 1-3, 5-8, 13-14, and cancels claims 4, 10, 15. Applicant's amendment has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 20 December 2004 have been fully considered but they are not persuasive. Applicant's argument that the prior art does not disclose determining whether a client system is close to the physical entity is not persuasive because Tracy discloses that the user terminals are usable only within the retail store which contains the central host (Fig. 1, 14) and for which the user has been authenticated using the customer smart card (Col. 7, line 61 – Col. 8, line 34). So for the embodiment of Tracy the client would in fact be at the physical entity.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., how the supermarket system tracks the location of a client system within the store) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant's argument that the prior art does not disclose that an electronic coupon is a location token as that term is used in claim 1 is not persuasive because Tracy discloses the use of electronic coupons available within the store (Col. 2, lines 47-54 & Col. 11, line 5-11) and would be considered a location token because these coupons are available only within the store.

5. Applicant's argument that the electronic coupons of Tracy do not have an expiration period is not persuasive because expiration dates or periods are an inherent quality for coupons, whether they are electronic or paper. The overwhelming majority of coupons have expirations associated with them.

6. Applicant's argument that the prior art does not disclose responsive to the location token in the first request being expired, the location authentication module causes the web server to provide content designed for an access request from a client system not close to the physical entity is not persuasive because Tracy discloses that if a coupon is not available for a particular product (Col. 12, lines 60-62) then the user terminal is provided with an external link to a web page containing information about other products that have coupons associated with them (Col. 13, lines 26-32).

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. It is believed that applicant's arguments with respect to claims 5-9, 11-14, have been fully responded to in view of the above paragraphs.

9. Applicant's arguments with respect to the double patenting rejections are not persuasive because:

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at

issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Therefore Applicant's argument that the copending application 09/633,077 does not contain functionality present in the current application is not persuasive because the current application contains all the elements and functionality of the '077 application.

Further, with respect to copending application 09/704,394, it would have been obvious to add the addition function of an identity authentication function to the current application in order to provide user authentication as taught in Tracy (Col. 7, lines 1-9).

Information Disclosure Statement

10. The information disclosure statement (IDS) submitted on 20 December 2004 was filed after the mailing date of the Non-Final Office Action on 20 August 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-3, 5, 6, 13, 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7, 8, 15 of copending Application No. 09/704,394 in view of Tracy, U.S. Patent No. 6,199,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the current application and copending Application '395 claim a web server system that comprises a web server that generates content regarding a physical entity in response to external requests, a location beacon adjacent to the physical entity to transmit a first beacon signal containing the web address and a second beacon signal containing a web address and a encrypted token, and a location authentication module that authenticates service requests by checking the token that accompanies the request with the respect to the token that was sent out in the second beacon signal. The current applicant does not contain an identity authentication function but Tracy discloses authenticated the user's of the system using smart cards. It would have been obvious to one of ordinary skill in the art at the time the invention was made add the addition function of an identity authentication function to the current application in order to provide user authentication as taught in Tracy (Col. 7, lines 1-9).

This is a provisional obviousness-type double patenting rejection.

13. Claims 1-3, 5-9, 11-14 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending

Application No. 09/633,077 in view of Kirsch, U.S. Patent 5,963,915. Both the current application and the copending application '077 disclose a web server system with:

A web server that hosts the content corresponding to a physical entity that is accessed externally via a web address.

A location beacon adjacent to the physical entity that transmits a beacon signal comprising a web address of the web site for the physical entity along with a token that has an expiration period.

A location authentication module that restricts access to the web server to requests that contain the proper unexpired token.

The difference between the applications is that the present application discloses the encryption of the token. It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the tokens in order to provide a secure venue for commercial transactions as taught in Kirsch (Col. 1, lines 54-56).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 1 recites the limitation "the key" in lines 17, 19, 21. There is insufficient antecedent basis for this limitation in the claim.

17. Claim 7 recites the limitation "the key" in lines 19, 21, 23, 31, 33. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 1-3, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy, U.S. Patent No. 6,199,753, in view of Kirsch, U.S. Patent No. 5,963,915. Referring to claims 1, 2, 13, Tracy discloses a portable shopping system wherein a central host (location beacon) transmits electronic coupons (token) along with a web page link (web address)(Col. 12, line 59 – Col. 13, line 40), which meets the limitation of a location beacon adjacent to the physical entity to transmit within a predetermined transmission range a first beacon signal containing a web address of the web server and a location token that expires within a predetermined time period, that is receivable by a customer's portable terminal (Fig. 2, Fig. 4). Tracy discloses that the transmission can be encrypted (Col. 6, lines 23-25), but does not disclose that the token is

encrypted. Kirsch discloses a system for secure internet transactions wherein upon user registration the user is provided with a cookie (token) that contains a server domain name and an expiration date (Col. 3, lines 13-20). When the user requests the URL of the web server (second request), the cookie is encrypted with the private key of the user and sent to a server (location authentication beacon) to be validated (Col. 13, lines 15- 45), which meets the limitations of a location authentication beacon adjacent to the physical entity and communicatively coupled to the location authentication module for receiving the key and location token and for encrypting a customized location token that expires in a predetermined tiem period using the key and for transmitting a second beacon signal within the predetermined transmission range containing the web address and a customized token encrypted using a key and a location authentication module for authenticating that the client system having received the first beacon signal is still close to the physical entity wherein the location authentication module receives a first request including the web address, the location token, and the key from the client system that has captured the first beacon signal if the first request contains the key and the token that has not expired, and causes the web server to service a second request from the client system if the second request contains the customized token that has not expired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the coupons (token) of Tracy in order to provide a secure venue for commercial transactions as taught in Kirsch (Col. 1, lines 54-56).

Referring to claim 3, Tracy discloses the use of coupons in the portable shopping system and by definition coupons expire.

21. Claims 5-9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy, U.S. Patent No. 6,199,753, in view of Kirsch, U.S. Patent No. 5,963,915 as applied to claim 1

above, and further in view of Schneier. Referring to claims 5-8, 13, Tracy discloses a portable shopping system wherein a central host (location beacon) transmits electronic coupons (token) along with a web page link (web address)(Col. 12, line 59 – Col. 13, line 40), which meets the limitation of a location beacon adjacent to the physical entity to transmit within a predetermined transmission range a first beacon signal containing a web address of the web server and a location token that expires within a predetermined time period, that is receivable by a customer's portable terminal (Fig. 2, Fig. 4). Tracy discloses that the transmission can be encrypted (Col. 6, lines 23-25), but does not disclose that the token is encrypted. Kirsch discloses a system for secure internet transactions wherein upon user registration the user is provided with a cookie (token) that contains a server domain name and an expiration date (Col. 3, lines 13-20). When the user requests the URL of the web server (second request), the cookie is encrypted with the private key of the user and sent to a server (location authentication beacon) to be validated (Col. 13, lines 15- 45), which meets the limitations of a location authentication beacon adjacent to the physical entity and communicatively coupled to the location authentication module for receiving the key and location token and for encrypting a customized location token that expires in a predetermined tiem period using the key and for transmitting a second beacon signal within the predetermined transmission range containing the web address and a customized token encrypted using a key and a location authentication module for authenticating that the client system having received the first beacon signal is still close to the physical entity wherein the location authentication module receives a first request including the web address, the location token, and the key from the client system that has captured the first beacon signal if the first request contains the key and the token that has not expired, and causes the web server to service a second

request from the client system if the second request contains the customized token that has not expired. Kirsch does not disclose that the encryption keys are random. Schneier discloses the use of randomly generated encryption keys (page 173). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use encryption keys generated randomly because randomly generated encryption keys are generally stronger as taught in Schneier (Page 173).

Referring to claim 9, Tracy discloses the use of coupons in the portable shopping system and by definition coupons expire.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th0 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin E. Lanier

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